

U. S. Application Serial No. **09/747,971**
Amendment dated October 3, 2003
Reply to Office Action **June 3, 2003**

REMARKS

Claims 7-10 and 12-20 are pending in this application. By this Amendment, claims 7-10, 16, and 17 are being amended. The applicants respectfully submit that no new matter has been added. It is believed that this Response is fully responsive to the Office Action dated June 3, 2003.

Claims 16-20 stand rejected under the second paragraph of 35 USC 112 as being indefinite. The applicants amended base claims 16 and 17 to remove any potential indefiniteness. Accordingly, in view of the foregoing, the applicants respectfully request that the Examiner withdraw the outstanding indefiniteness rejection of claims 16-20.

Claims 7-10 and 12-15 stand rejected under 35 USC 103(a) as being unpatentable over US Patent No. 5,295,331 (**Honda '331**) in view of US Patent No. 4,778,730 (**Zucker '730**) and Japanese Patent Publication No. 11-320231 (**JP '231**). The applicants respectfully request reconsideration of this rejection.

To establish a *prima facie* case of obviousness, for a rejection of claims under 35 U.S.C. § 103, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable

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expectation of success. Third, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See the *Manual of Patent Examining Procedure* (M.P.E.P.) §§ 706.02(j) and 2143.

JP '231 shows a cylindrical block workpiece W being held by contacting its outer circumferential surface (see FIG. 2 of **JP '231**), **Honda '331** discloses a thin workpiece (see wafer 20 in FIG. 4), and we believe there would be a high risk of damage to the workpiece wafer 20 if the workpiece wafer 20 were to be held by its thin edge (outer circumferential surface) in the manner taught by **JP '231** during chamfering.

Claims 7 and 10 have been amended to further clarify the claimed invention. Claim 8 has been amended to cause the claim language to conform to that of claim 7, as amended. Claim 9 has been amended to remove an informality.

More particularly, claims 7 and 10 have been amended to better define the shape of the workpiece and to better define the manner in which the workpiece is held.

The applicants respectfully believe that **Honda '331** in view of **Zucker '730** and **JP '231** fail to teach or suggest the features set forth in claims 7-10 and 12-15, as amended.

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The applicants respectfully submit that there is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify/combine reference teachings to arrive at the claimed inventions as set forth in claims 7 and 10, as amended. Furthermore, the applicants respectfully submit that the cited prior art references fail to teach or suggest all the features set forth in claims 7 and 10, as amended. In particular, the work holding portion, as set forth in claims 7 and 10, as amended, is not taught or suggested by the references.

Accordingly, in view of the foregoing, the applicants respectfully request that the Examiner withdraw the outstanding obviousness rejection of claims 7-10 and 12-15.

Entry of the foregoing amendments is proper under 37 C.F.R. § 1.116 because those amendments comply with requirements of form expressly set forth in the previous Office action or present rejected claims in better form.

In view of the aforementioned amendments and accompanying remarks, claims 7-10 and 12-20, as amended, are in condition for allowance, which action, at an early date, is requested.

If, for any reason, it is felt that this application is not now in condition for allowance, the Examiner is requested to contact the applicants' undersigned attorney, at the telephone number indicated below, to arrange for an interview to expedite the disposition of this case.

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In the event this response is not timely filed, the applicants petition for an appropriate extension of time. Please charge any fees for such an extension of time and any other fees which may be due with respect to this paper, to Deposit Account No. 01-2340.

Respectfully submitted,

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PATENT TRADEMARK OFFICE

Enclosure: Petition for Extension of Time

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